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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,268 10/13/99 CHENCHIK

A CLON-008

EXAMINER

HM22/0105

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ART UNIT

PAPER NUMBER

1655

DATE MAILED:

01/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/417,268

Examiner

BJ Forman

Applicant(s)

CHENCHIK, ALEX

Art Unit

1655

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 Dember 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation of Advisory Acton.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☐ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-17, 53 and 57-59.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other:

Continuation of Advisory Action

1. The Declaration filed under 37 C.F.R §1.132 does not place the application in condition for allowance because the experimental results presented in the declaration demonstrate that the cooperative effect which leads to the increased hybridization signal is highly dependent upon the target-probe combination i.e. for two of the five groups of gene-derived oligonucleotide probes, the signal intensity of the probe mixture was roughly the same as the sum of the signal intensity of each individual probe and therefore the unexpected result was not universal, but highly probe-target dependent. Additionally, cooperative hybridization of multiple probes for a target was well established in the art at the time the claimed invention was made and one skilled in the art would expect an increased signal from multiple probes when compared to individual probes. Because cooperative binding was known in the art, it is not unexpected that some groups of gene-derived probes would produce an increased hybridization signal. Hence, the results presented in the declaration are expected, not unexpected.

2. The amendments to the claims have not been entered because the proposed amendments do not place the claims in condition for allowance and the amendments are not germane to the rejection over Brown et al. who teaches an array comprising a pattern of probe spots.

Response to Arguments

3. Applicant argues that the examiner incorrectly equates the instant probe spots with the cells of Brown et al. because the probe spots as recited in the amended claims have a diameter not taught by Brown et al. This argument is not found persuasive because Brown et al. teach the cells having a wide range of dimension. The courts have stated that when the only difference between the prior art and the claims was in the recitation of dimensions, the claimed

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invention was not patentably distinct over the prior art (see *Garner v TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777).

Applicant further argues that Fodor et al., Lockhart et al. and Stratagene fail to overcome the deficiency of Brown et al. and therefore, their combined teaching does not teach or suggest the claimed invention. This argument is not found persuasive for the reasons stated above with regard to the Brown et al. reference.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.
January 3, 2001

